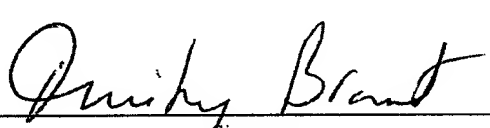


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number:  06975-088001
<p>I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.</p> <p>_____</p> <p>Date of Deposit</p> <p>_____</p> <p>Signature</p> <p>_____</p> <p>Typed or Printed Name of Person Signing Certificate</p>	Application Number  09/893,693	Filed  June 29, 2001
	First Named Inventor  Richard A. Watson, Jr.	
	Art Unit  2157	Examiner  El Chanti, Hussein A.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record (Reg. No.)</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 59,133</p> </div> <div style="width: 45%; text-align: center;">   <p>_____ Signature Dmitry Brant _____ Typed or printed name _____ (202) 783-5070 _____ Telephone number _____ February 25, 2008 _____ Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>		
<input checked="" type="checkbox"/> Total of 1 forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Richard A. Watson, Jr.	Art Unit	: 2157
Serial No.	: 09/893,693	Examiner	: El Chanti, Hussein A.
Filed	: June 29, 2001	Conf. No.	: 4959
Title	: ENABLING COMMUNICATIONS OF ELECTRONIC DATA BETWEEN AN INFORMATION REQUESTOR AND A GEOGRAPHICALLY PROXIMATE SERVICE PROVIDER		

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005, New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 30-40, 42-44, 46-55, and 60-65 are pending and stand rejected, with claims 30, 40, and 42 being independent. Claims 1-29, 41, and 45 have been cancelled, and claims 56-59 have been withdrawn. Appellants respectfully disagree with, and hereby ask the panel to review and reverse, this rejection.

**Discussion**

It is a well-established principle of patent examination that every limitation in the claim must be considered. MPEP § 2106.II.C. Moreover, when setting forth a rejection, the Office Action must clearly communicate its findings, conclusions and their bases to the Applicants. MPEP § 2106.VII. The Final Office Action and the Advisory Actions in the instant case have failed to follow the above principles because they (1) maintained a rejection based on the *wrong version* of the claim language and (2) offered additional arguments based on the claim language that *has never appeared in the presented claims*.

Specifically, in their Reply from May 8, 2007, Applicants have amended independent claims 30, 40, and 42. For example, claim 1 was amended to recite "from receiving, at a primary communications system configured to act as an access point to the Internet for data

communications between the client system and the Internet, a request to access the Internet that is directed to the primary communication system, wherein the request is issued by an online identity operating the client system.<sup>1</sup> See e.g., Reply to Non-Final Office Action of May 8, 2007, page 2. Other independent claims were amended in a similar manner.

However, Applicant's amendments were not properly addressed in the Final Office Action from October 24, 2007. In particular, the Final Office Action first rejected the amended claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection was clearly improper, as evidenced by the fact that it was subsequently withdrawn in the Advisory Action. See Advisory Action of January 25, 2008, page 3.

The only other rejection in the Final Office Action was based on the 35 U.S.C. § 102(e) rejection of the *old claims*, not the newly amended claims. In greater detail, the Office Action stated that Applicant's arguments with respect to the amended claims were moot in view of the *new* grounds of rejection. However, an inspection of the Final and Non-Final Office Actions reveals that the grounds for the 35 U.S.C. § 102 (e) rejection of claims 30-40, 42-44, 46-55 in the Final Office Action were copied verbatim from the non-Final rejection. See non-Final Office Action from February 12, 2007. Consequently, the 102(e) rejection did not address the new limitations. The new claims 60-65 were also rejected using an omnibus rejection that failed to set forth rationale suggesting how their steps are individually met by the asserted references. See MPEP § 707.07(d).

In summary, the finality of the Final Office Action of October 24, 2007 was based solely on an improper 35 U.S.C. § 112 rejection that has since been withdrawn. The record is devoid of any evidence to suggest that the amended claims were considered or substantively addressed by the Office. For these reasons, the finality of the Office Action from October 24, 2007 was clearly improper. See MPEP § 706.07(a).

Moreover, the Advisory Action from January 25, 2008 once again relies on **the no-longer-pending claim language**. In particular, the Advisory Action states:

In response to applicant's arguments that Tarnanen does not teach a **first communication system** that identifies a second communication system acting as an access point, the rejection is

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<sup>1</sup> Amendments are underlined.

maintained because Tarnanen teaches a system and method including a mobile station that receives a request to access the internet from a user and in response, determines an ISP that is capable of servicing the request (see col. 7 lines 15-45). Since the mobile station enables the user to access the internet, the mobile station is interpreted to be "**first communicaiton [sic] system**". There is no claim limitation that suggests that the mobile station may not be interpreted as "**first communication system**" such as for example stating that the first communication system is a device remote from the client device, therefore examiner believes that the interpretation is reasonable.

See Advisory Action of January 25, 2008, page 3 (emphasis added)

However, claim 1 **does not** recite "a first communication system." Instead, claim 1 recites three distinct systems: "a client system," "a primary communications system," and "a secondary communications system." Therefore, it is unclear what the Examiner means by the "first communication system." Such ambiguous explanation is improper under MPEP § 2106.VII, which states that the Examiner's reasoning must be clearly communicated to the Applicants. In addition, this is the first time that the Examiner apparently addressed the amended claims (albeit relying on the wrong language), and, as it is well-known, new grounds for rejection should not be introduced in the Advisory Action. *See* MPEP 706.07.

Finally, the reasoning expressed with respect to the claims is incorrect. For example, even assuming *arguendo* that the Examiner equates the "first communication system" to the "client system," such interpretation is clearly incorrect, since the client system cannot receive a request from itself to access the Internet, as required by claim 1.

If, on the other hand, the Examiner equates the "first communication system" to the "primary communications system," then the Examiner's reliance on the mobile station of Tarnanen to meet this term is incorrect, since the mobile station in Tarnanen acts as "a client system" rather than "a primary communications system." According to claim 1, the primary communications system must receive "a request to access the Internet, wherein the request is issued by an online identity operating the client system." However, the mobile station Tarnanen does not receive any requests from another system to access the Internet. In contrast, it actually *generates* these requests, as evidenced by the specification and figures. See FIG. 1 and FIG. 4, Col. 7:15-30. Therefore, the mobile station of Tarnanen cannot be "the primary communications system," as it does not perform the functionality of "the primary communications system" that is required from it by the claim language.

Furthermore, as a matter of proper claim construction, the mobile station cannot be interpreted as **both** "a client system" and "a primary communication system," since such interpretation is inconsistent with the well-established law, which states that different claim terms must be presumed to have different meanings. *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) ("In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings."); *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006) ("[T]he use of two terms in a claim requires that they connote different meanings. . . ."). Because independent claims 30, 40, and 42 intentionally use distinct terms for "a client system" and "a primary communication system," it is improper for the Examiner to point to a single "mobile station" to meet both limitations, especially in light of the fact that Tarnanen does not use the mobile station as both "a primary communications system" and "a client system," as explained above.

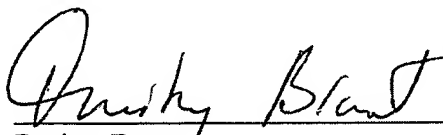
Based on the foregoing arguments and remarks, independent claims 30, 40, and 42 are believed to be allowable over the applied reference.

Applicants request reversal of the rejection of record and either issuance of a new office action properly addressing the amended claims or allowance of these claims.

The request is being filed with a Notice of Appeal. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 2/25/08

  
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